

### **REMARKS**

Prior to entry of this paper, claims 1-9, 13, 18, and 30-44 were pending in the application. Upon entry of this paper, claims 1-9, 13, 30, 31, and 33-37 will be pending in the application. Claims 18, 32, and 38-44 will be cancelled without prejudice to or disclaimer of the subject matter therein. Claim 30 will be amended from previous versions. Claims 4-9, 13, and 33-37 are allowed, and claim 30 is amended herein to include the subject matter of allowable claim 32.

In the final Office Action, claims 1-3 are indicated as allowed, but as discussed in the Examiner Interview Section below, the allowability is being withdrawn. Applicants request a non-final Office Action formally withdrawing the allowability.

This pending application is a reissue continuation of 09/776,394, which is a reissue application of U.S. Patent No. 5,865,846.

#### **Reissue Oath/Declaration**

The Office Action indicates that the reissue oath/declaration is defective because it fails to contain the correct language and that a new declaration must be filed before the application can be allowed. Applicants are working to obtain the new oath signed by all the inventors and intend to file it in response to the next Office Action.

#### **Examiner Interview**

Applicants appreciate the Examiner's willingness to discuss this matter. The Examiner indicated that claims 1-3 must be cancelled for provisional double patenting over claims of parent reissue Application No. 09/776,394. In response to this paper, Applicants respectfully request a non-final Office Action formally withdrawing the allowability of claims 1-3.

The Examiner also indicated that a new oath must be filed. Applicants are working to obtain the new oath, as discussed above.

#### **Allowable Subject Matter**

Applicants acknowledge the indication that claims 4-9, 13, and 33-37 are allowed, with claim 32

being allowable. By this paper, Applicants amend claim 30 to include the allowable subject matter of claim 32 and cancel claim 32 from the application. Accordingly, claims 4-9, 13, 30, 31, and 33-37 are in condition for allowance.

Applicants acknowledge the indication that claims 1-3 are allowed, but also acknowledge the telephone discussion where the Examiner indicated that claims 1-3 should be rejected for provisional double patenting. Applicants request that a non-final Office Action be issued formally withdrawing such allowability.

### Claims

The Office Action indicates that the claims stand rejected as being based upon a defective oath or declaration. Pg. 4. As stated above, Applicants are working to obtain a properly worded oath for submission to the Patent Office.

The rejection of the claims is rendered moot by the cancellations proposed herein. For the convenience of the Examiner, claim 30 is reproduced below to show the changes introduced in this paper.

30. (Currently amended) A method of surgery comprising:  
removing at least a portion of a natural spinal disc from between confronting vertebral bodies;  
forming partially hemispherical surfaces in endplates of the confronting vertebral bodies, the partially hemispherical surfaces being different from a natural surface of the endplates; and  
inserting between the formed partially hemispherical surfaces an intervertebral disc prosthesis comprising confronting supports, each support having a partially hemispherical exterior surface adapted to mate with one of the formed partially hemispherical surfaces, wherein the supports are capable of movement relative to each other after the prosthesis has been inserted between the formed partially hemispherical surfaces;  
prior to forming the partially hemispherical surfaces in the vertebral body endplates,  
implanting at least one anchor into a hole having a predetermined position in an anterior surface of at least one of the confronting vertebral bodies; and  
affixing a bone surface milling mechanism to the at least one anchor.

**Dependent Claim 31**

Dependent claim 31 depends from and further limits independent claim 30 and therefore also is deemed to be patentable over the prior art.

**Conclusion**

An early notice that claims 4-9, 13, 30, 31, and 33-37 are allowed is requested. The final Office Action contains characterizations of the claims and the related art to which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Final Office Action.

If the Examiner believes a telephone conversation would be useful for advancing prosecution of this application, he is invited to telephone the undersigned at 972-739-6969.

Applicants believe a two-month extension of time and fees are required for filing with this paper. If any additional fees, including additional claim fees and extension of time fees, are necessary for the proper submission of this paper, Applicants hereby petition for the extension of time, and the Commissioner is authorized to charge any fees, including claim fees and those for the extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

Respectfully submitted,



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I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on June 9, 2008.



Diane Sutton